



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,556	06/13/2001	Harold Brodie	S1011	9517
3000	7590	10/05/2005	EXAMINER	
CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212			GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,556

Applicant(s)

BRODIE ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

It does not accurately reflect the status of the claims. Applicant states that claim 28 has been amendment however no amendment has been made to claim 28. Note that only claims 12-14, 17-18, 23, 26 and 29 have been amended in the latest amendment. Applicant states that claim 30 has been canceled by preliminary amendment however the examiner is unable to find an amendment specifically canceling this claim.

2. Claims 1-30 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defects in the declaration is set forth in the discussion above in this Office action.

3. Claims 12-13 and 17-32 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claims 21-23 and 25-26 the types and amounts of the biocides are not supported by the specification as originally filed. Applicant previously argued that since the reference teaches that "Many biocides may be suitably employed in the invention

Art Unit: 1755

and the average skilled man of the art would readily be able to determine by routine experimentation whether the biocidal activity of any particular biocide will be sufficiently retained from his particular needs in the coating" and now argues that "First, the specification says that the skilled reader would be able to identify materials of biocide by "routine experimentation," see the bottom of page 2 of the original specification.

Second, U.S. Patent No. 6,093,407 discloses the use of many biocides which Applicants contend are properly part of the Brodie and Clover invention. Applicants are attempting to institute an interference with this application on the ground that Applicants were the first to conceive and reduce to practice Applicants' claimed invention. The biocides in the 1407 patent are identified by chemical name and trade mark. This demonstrates that they have been in the public domain for some time. Further, the examples in this patent show that the testing is all routine.

To this argument the examiner respectfully disagrees as it is the position of the examiner that the types found in the claims are not obvious from the disclosure as the particularly claimed types and amounts cannot be readily implied from the disclosure. That is, the specification provides no guidance as to the use of the particularly claimed types and amounts. As stated previously applicant is appearing to use "hind-sight" which is improper. It is the position of the examiner that the applicant is using hind-sight as there is nothing in the specification that would lead one to use those biocides now being claimed and applicant has not provided any convincing evidence to that effect. Note that the specification lists suitable classes of biocides that may be listed and note that none of those now recited in the claims fall within the suitable classes. It is the position

that if the newly added biocides were members of the classes taught by the reference, then their addition would not be considered to be new matter.

In claim 28 applicant recites a temperature for baking the thermoplastic polymer however this is not supported by the specification. Applicant argues that it is obvious to the skilled worker in this field that the baking temperature should be adjusted accordingly when using thermoplastic polymer powders in place of thermosetting polymers, therefore this feature is implicit supported by the disclosure. It is the position of the examiner that this is not implicitly supported by the reference as the reference provides no guidance as to baking thermoplastic polymer powders. The temperature range recited in the specification for the thermosetting powders is for curing the thermosetting powders as the "stoving temperature" is the curing temperature. Since thermoplastic polymers are not cured like thermosetting polymers, it is the position of the examiner that the claim is not supported by the specification as the instant specification is concerned with "curing" and not "baking". Again applicant appears to be using "hind-sight" which is improper. Further with respect to applicant's arguments concerning this rejection applicant states that the claim has been amended however no amendment has been made to claim 28.

In claim 30 no support can be seen for the use of a solid support material. It is noted that applicants recite in the declaration that this claim has been canceled by preliminary amendment however the examiner is unable to specifically find an amendment which cancels this claim.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12-13 and 17-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

See the new matter rejection under 35 USC 251 (Item #3 above) for the reasons.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 17 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17 the phrase "the polymer powder" lacks proper antecedent basis. Also it appears that the recited resins are thermosetting resins and not thermoplastic resins. Accordingly it appears that no thermoplastic resin is recited in the claim. It is noted that applicant has not commented on this previously made rejection.

Art Unit: 1755

In claim 30 the phrase "the coating pre-mix" lacks proper antecedent basis. As stated previously the examiner cannot find any amendment that specifically cancels this claim and accordingly the rejection is repeated.

8. Claims 12-14 and 17-32 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the parent application applicant amended the claims to recite (1) that the polymer powder is a thermosetting polymer, (2) that the biocide is organic in nature and (3) that the composition is in the form of particulates each comprising the polymer powder containing the biocide in order to overcome the art rejections and accordingly since all these limitations are not present in independent claims 12, 17-18 and 28 it appears that applicant is attempting to recapture subject matter surrendered in the

Art Unit: 1755

parent application. Applicant's attention is drawn to the pages 4-5 of the response filed on 21 May 1999 in the parent application wherein applicant argue that the insertion of these limitations overcomes the art rejections. Applicant previously argued that this is not the case as the amendment were made merely for clarification. It is the examiner's position that the amendments were made to overcome the art rejections and therefore the broader scope was surrendered and applicant is arguing now that "The claims of the parent application were allowed because inorganic biocides were excluded and that was the purpose of the amendment which Applicants made at that time. Applicants do not in the present application attempt to recapture that subject matter by asking for patent coverage for inorganic biocides and for this reason, Applicants request that this ground of rejection be withdrawn. To these arguments the examiner respectfully disagrees as the claims in question are not limited to a thermosetting polymer, that the biocide is organic in nature and that the composition is in the form of particulates each comprising the polymer powder containing the biocide. Note that claim 12 does not recite these limitations as it does not recite that the anti-microbial agent is organic in nature and that the resin is thermosetting and that the composition is in the form of particulates each comprising the polymer powder containing the biocide. Note also that claims 13 and 17 does not require that the polymer be thermosetting as it could be thermoplastic. Accordingly it is the position of the examiner that applicant is improperly trying to recapture subject matter that was surrendered previously.

Art Unit: 1755

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claim 28 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13 of prior U.S. Patent No. 6,129,782. This is a double patenting rejection.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,129,782.

Although the conflicting claims are not identical, they are not patentably distinct from

Art Unit: 1755

each other because the reduction to claims of the prior patent would render obvious the instant claims.

Claim 11 of the prior patent is encompassed by the instant claim 17 as instant claim 17 is broad enough to encompass the claim. Claim 17 relates to a method using thermosetting and/or thermoplastic resins whereas claim 11 of the prior patent relates to just thermoplastic resins.

Regarding applicants arguments concerning the rejection of claims 17 and 28 for double patenting, Applicant argues that the scope of these claims is based upon Applicants' disclosure and that in an interference, even as a junior party, Applicants should be entitled to demonstrate that in fact, they were the first to conceive and reduce to practice the invention claimed in claims 17 and 28.

It is not seen as to how these arguments overcome the double patenting and obviousness-type double patenting rejections.

Claim Objections

13. Claim 17 is objected to because of the following informalities: The phrase "the each of the particles" should be changed to -- each of the particles --. Appropriate correction is required.

Request To Provoke Interference

14. Applicant's request to provoke an interference is acknowledged however it should be noted that no interference can be declared until there is at least one allowable claim which corresponds to a proposed count of the interference.

Conclusion

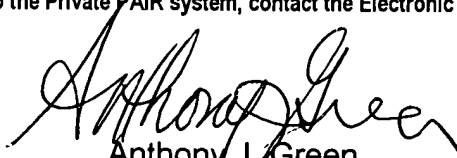
15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony J. Green
Primary Examiner
Art Unit 1755